UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,390	11/25/2003	Kazunori Ando	16869N-101600US	8868

20350 7590 01/18/2007		EXAMINER
TOWNSEND AND TOWNSEND AND CREW, LLP		POPHAM, JEFFREY D
TWO EMBARCADERO CENTER		
EIGHTH FLOOR	ART UNIT	PAPER NUMBER
SAN FRANCISCO, CA 94111-3834	2137	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/723,390	ANDO ET AL.
	Examiner	Art Unit	
	Jeffrey D. Popham	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO,EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 November 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>25 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>20031125</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Remarks

Claims 1-13 are pending.

A machine-translated version of Japanese publication number 11-306301 (from

IDS), obtained from http://www.ipdl.ncipi.go.jp/homepg_e.ipdl, has been included.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1.   Claims 1, 2, 5, 7, 8, and 12 are rejected under 35 U.S.C. 102(b) as being

anticipated by Lane (U.S. Patent 5,623,52).

Regarding Claim 1,

Lane discloses an IC card to be used for individual authentication

or settlement comprising:

An input device for individual authentication information of a user of

the IC card (Figures 1A and 2; and Column 5, lines 6-20);

A use condition storage device for storing a term of validity of the

authentication information or collation results of the authentication

information and use conditions of the IC card (Figures 1A and 2; Column

5, line 21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15;

the predetermined elapsed time inherently must be stored in a storage

device of the card); and

A controller for controlling the term of validity of the IC card on the

basis of collation results of the authentication information with the use

condition information (Figures 1A and 2; Column 5, line 21 to Column 6,

line 12; and Column 8, line 33 to Column 9, line 15).

Regarding Claim 2,

Lane discloses that the input device for the individual authentication

information is comprised of input devices for biometrics information

concerning any of a fingerprint, an iris, a voiceprint, and a retina print

(Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column

9, line 15).

Regarding Claim 5,

Lane discloses that the controller makes the IC card usable for a

predetermined time period on the basis of individual authentication

information inputted into the IC card, and makes the IC card unusable

after a lapse of the time period (Column 5, line 21 to Column 6, line 12;

and Column 8, line 33 to Column 9, line 15).

Regarding Claim 7,

Lane discloses an IC card to be used for individual authentication

or settlement, comprising functions for:

Inputting fingerprint information of a user of the IC card (Column 5,

line 21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15);

Collating the inputted fingerprint information with fingerprint

information of a user of the IC card registered in advance (Column 5, line

21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15); and

When the collation results in coincide, making the IC card valid

during a predetermined term of validity to make use of the IC card

possible (Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to

Column 9, line 15).

Regarding Claim 8,

Lane discloses a function for making use of the IC card impossible

after an elapse of the predetermined time period (Column 5, line 21 to

Column 6, line 12; and Column 8, line 33 to Column 9, line 15).

Regarding Claim 12,

Lane discloses a method of controlling a term of validity of an IC

card to be used for individual authentication or settlement, comprising the

steps of:

Inputting authentication information of a user of the IC card

(Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column

9, line 15);

Collating the authentication information inputted with authentication

information of the user of the IC card registered in advance (Column 5,

line 21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15);

Making the IC card usable when the collation results in coincidence

(Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column

9, line 15);

Monitoring an elapse of a time period since the IC card is made

usable (Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to

Column 9, line 15); and

Making the IC card unusable when a predetermined term of validity

of the IC card has elapsed (Column 5, line 21 to Column 6, line 12; and

Column 8, line 33 to Column 9, line 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 3, 4, 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Lane in view of Yano (JP 11-306301).

Regarding Claim 3,

Lane discloses that the use condition storage device records a term of validity of the IC card for every application program of the IC card (Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15); but does not disclose storing a separate term of validity for every application program.

Yano, however, discloses that the use condition storage device records a term of validity of the IC card for every application program of the IC card and storing a separate term of validity for every application program (Paragraphs 14-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the security system of Yano into the IC card of Lane in order to allow flexibility in terms of validity and authentication, such that terms of validity will be set and authentication parameters will be validated in accordance with the particular application/object of use of the card, thereby increasing security and control of such security.

Regarding Claim 4,

Lane discloses that the use condition storage device records judgment conditions during collation of individual authentication information inputted every application program of the IC card (Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15); but does not disclose that each application program may have separate collation conditions.

Yano, however, discloses that the use condition storage device

records judgment conditions during collation of individual authentication

information inputted every application program of the IC card and that

each application program may have separate collation conditions

(Paragraphs 14-20). It would have been obvious to one of ordinary skill in

the art at the time of applicant's invention to incorporate the security

system of Yano into the IC card of Lane in order to allow flexibility in terms

of validity and authentication, such that terms of validity will be set and

authentication parameters will be validated in accordance with the

particular application/object of use of the card, thereby increasing security

and control of such security.

Regarding Claim 10,

Lane discloses that the term of validity will be set in accordance

with an object of use of the IC card (Column 5, line 21 to Column 6, line

12; and Column 8, line 33 to Column 9, line 15); but does not disclose that

different objects of use may have different terms of validity.

Yano, however, discloses that the term of validity will be set in

accordance with an object of use of the IC card and that different objects

of use may have different terms of validity (Paragraphs 14-20). It would

have been obvious to one of ordinary skill in the art at the time of

applicant's invention to incorporate the security system of Yano into the IC

card of Lane in order to allow flexibility in terms of validity and

authentication, such that terms of validity will be set and authentication

parameters will be validated in accordance with the particular

application/object of use of the card, thereby increasing security and

control of such security.

Regarding Claim 11,

Lane discloses that the collation condition of the fingerprint

information will be set in accordance with an object of use of the IC card

(Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column

9, line 15); but does not disclose that separate collation conditions may be

stored in accordance with separate objects of use.

Yano, however, discloses that a collation condition of the fingerprint

information will be set in accordance with an object of use of the IC card

and that separate collation conditions may be stored in accordance with

separate objects of use (Paragraphs 14-20). It would have been obvious

to one of ordinary skill in the art at the time of applicant's invention to

incorporate the security system of Yano into the IC card of Lane in order

to allow flexibility in terms of validity and authentication, such that terms of

validity will be set and authentication parameters will be validated in

accordance with the particular application/object of use of the card,

thereby increasing security and control of such security.

Regarding Claim 13,

Lane does not disclose changing the term of validity of the IC card in accordance with an object of use of the IC card.

Yano, however, discloses changing the term of validity of the IC card in accordance with an object of use of the IC card (Paragraphs 14-20). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the security system of Yano into the IC card of Lane in order to allow flexibility in terms of validity and authentication, such that terms of validity will be set and authentication parameters will be validated in accordance with the particular application/object of use of the card, thereby increasing security and control of such security.

3.   Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane in view of Wong (U.S. Patent 6,592,044).

Regarding Claim 6,

Lane discloses that the IC card has a display unit for displaying whether or not the IC card can be used; and that the controller lights the display unit when the IC card can be used (Column 5, line 21 to Column 6, line 12; and Column 8, line 33 to Column 9, line 15);

But does not disclose lighting the display unit at all times during which the IC card be used; and putting out the display unit when the IC card cannot be used.

Wong, however, discloses that the IC card has a display unit for displaying whether or not the IC card can be used; and the controller lights the display unit when the IC card can be used, and puts out the display unit when the IC card cannot be used (Column 12, line 41 to Column 13, line 3; and Column 17, line 58 to Column 18, line 25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the display techniques of Wong into the IC card of Lane in order to inform the user of when the card is still active and able to be used and when the card is inactive and the temporary data stored thereon is deleted.

Regarding Claim 9,

Lane does not disclose that the IC card displays that the IC card is valid during the term of validity, and that the IC card is not valid after an elapse of the term of validity.

Wong, however, discloses that the IC card displays that the IC card is valid during the term of validity, and that the IC card is not valid after an elapse of the term of validity (Column 12, line 41 to Column 13, line 3; and Column 17, line 58 to Column 18, line 25). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the display techniques of Wong into the IC card of Lane in order to inform the user of when the card is still active and able to be used

and when the card is inactive and the temporary data stored thereon is

deleted.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jeffrey D. Popham whose telephone number is (571)-

272-7215. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Emmanuel Moise can be reached on (571)272-3865. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey D Popham
Examiner
Art Unit 2137

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER